

Notice of Allowability

Application No.

10/588,331

Examiner

Hannah Pak

Applicant(s)

HAYASHI ET AL.

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 03/18/2010.
2. ☒ The allowed claim(s) is/are 1-6,8-11 and 13.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>February 22, 2010</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

/Hannah Pak/
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 04/22/2010 has been entered.
2. The petition to revive filed 03/18/2010 is noted but is rendered moot by the filing of a RCE.
3. It is also noted that the examiner's amendment is identical to the one set forth on 03/01/2010, and though redundant, is being reproduced for completeness of record.

EXAMINER'S AMENDMENT

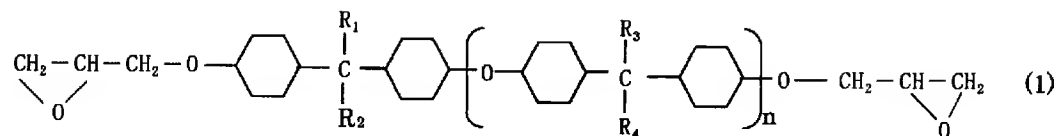
4. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Timothy Trop on February 22, 2010.

The application has been amended as follows:

Claim 2 is amended as follows:

2 (Currently Amended). A neutron shielding material composition comprising a hydrogenated bisphenol epoxy represented by the following structural formula (1):



wherein each of R₁ to R₄ is independently selected from the group consisting of CH₃, H, F, Cl and Br, and n is from 0 to 2;

a refractory material having higher density than that of the hydrogenated bisphenol resin;

a curing agent component having at least one ring structure and a plurality of amino groups;

a density-increasing agent having higher density than that of the refractory material; ~~and~~

a boron compound,

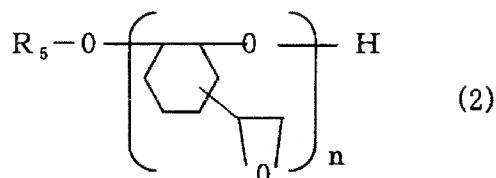
wherein said neutron shielding material composition maintains the density of a base resin comprising said curing agent component and the refractory material[[]]; and

wherein density of the neutron shielding material composition is from 1.62 g/cm³ to 1.72 g/cm³.

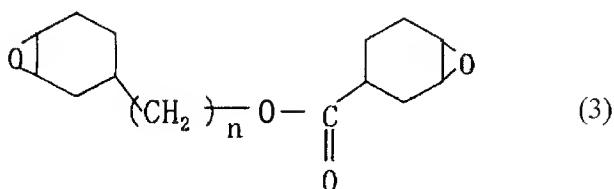
Claim 3 is amended as follows:

3 (Currently Amended). The neutron shielding material composition according to claim 1, further comprising one or more compounds selected from the group consisting of a ~~compound~~ compounds represented by the structural formulas (2), (3), (6) and (9):

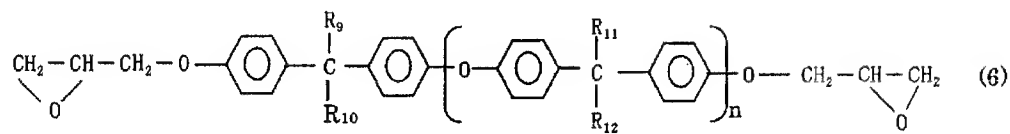
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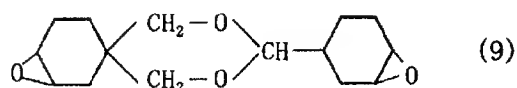
wherein R_5 is a C1-10 alkyl group or H, and n is from 1 to 24;



wherein n is from 1 to 8;



wherein each of R_9 to R_{12} is independently selected from the group consisting of CH_3 , H, F, Cl and Br, and n is from 0 to 2; and



Claim 10 is amended as follows:

10 (Currently Amended). A neutron shielding material obtained ~~obtainable~~ from the neutron shielding material composition according to claim 1 or claim 2.

Claim 11 is amended as follows:

11 (Currently Amended). A neutron shielding container obtained ~~obtainable~~ from the neutron shielding material composition according to claim 1 or claim 2.

Abstract is amended as follows:

Please delete the Abstract and substitute the following in lieu thereof:

A neutron shield material that exhibits high heat resistance and ensures neutron shielding capacity. A composition for neutron shield material excelling in heat resistance and ensuring neutron shielding capacity is provided by comprising a hydrogenated bisphenol type epoxy of the formula: (1) (wherein each of R_1 to R_4 is independently selected from the group consisting of CH_3 , H, F, Cl and Br, and $n = 0$ to 2), a hardening agent component having at least one cyclic structure and two or more amino groups, a density increasing agent and a boron compound.

5. The claims are renumbered as follows:

Claim 1 becomes claim 1.

Claim 2 becomes claim 2.

Claim 3 becomes claim 3, which depends on claim 1; reads "The neutron shielding material composition according to claim 1."

Claim 4 becomes claim 4, which depends on claim 1; reads "The neutron shielding material composition according to claim 1."

Claim 5 becomes claim 5, which depends on claim 1; reads "The neutron shielding material composition according to claim 1."

Claim 6 becomes claim 6, which depends on claim 1; reads "The neutron shielding material composition according to claim 1."

Claim 8 becomes claim 7, which depends on claim 1; reads "The neutron shielding material composition according to claim 1."

Claim 9 becomes claim 8, which depends on claim 1 or claim 2; reads "The neutron shielding material composition according to claim 1 or claim 2."

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Claim 10 becomes claim 9, which depends on claim 1 or claim 2; reads “A neutron shielding material obtained from the neutron shielding material composition according to claim 1 or claim 2.”

Claim 11 becomes claim 10, which depends on claim 1 or claim 2; reads “A neutron shielding container obtained from the neutron shielding material composition according to claim 1 or claim 2.”

Claim 13 becomes claim 11, which depends on claim 7; reads “The neutron shielding material composition according to claim 7.”

Reasons for Allowance

6. The present claims are allowable over the “closest” prior art, namely **Hayashi** (JP 2003-066189) and **Anayama et al.** (EP 0 628 968 A1).

The broadest claim, independent claim 1, recites as follows:

1 (Previously Presented). A neutron shielding material composition comprising:
a hydrogenated bisphenol resin;
a refractory material having higher density than that of the hydrogenated bisphenol resin;
a density-increasing agent having higher density than that of the refractory material;
a curing agent component;
a boron compound,
wherein said neutron shielding material composition maintains the density of a base resin comprising said curing agent component and the refractory material; and
wherein density of the neutron shielding material composition is from 1.62 g/cm³ to 1.72 g/cm³.

According to page 16 of the present specification, the density claimed is obtained, via employing 5-40 mass percent of density-increasing agents based on the total amount of the neutron shielding material composition. The density-increasing agent is identified as metal powders (see Page 15 of the present specification). None of the references cited teaches or would have suggested a neutron shielding material composition having the claimed specific ingredients with the density of 1.62 g/cm^3 - 1.72 g/cm^3 .

Hayashi, relied upon as the primary reference in the previous action, for example, discloses a neutron shielding material composition having **1)** a hydrogenated bisphenol resin, **2)** a boron compound, **3)** a refractory material having higher density than that of the hydrogenated bisphenol resin, and **4)** a curing agent component (Paragraphs 1, 9, and 36-37).

Hayashi does not teach or suggest forming a neutron shielding material composition having the claimed density, much less utilizing a density increasing agent, for the purpose of obtaining a neutron shielding material composition having a density.

Anayama et al., relied upon as the secondary reference in the previous action, do not remedy the deficiency in Hayashi et al.

Anayama et al. fail to mention forming the neutron shielding material composition having any particular density. In fact, it employs density-increasing agents, such as metal powders, in an amount that would not form the neutron shielding composition having the claimed density. In particular, **Anayama et al.** teach employing

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equal to or greater than 50 parts by weight of density increasing agent based on the total amount of the neutron shielding material composition (Page 3, lines 30-45).

According to page 16 of the present specification, the use of such amount will suggest away from forming the neutron shielding material composition having the claimed density.

7. Additional pertinent prior arts have been uncovered in further search.

Specifically, **Carden** (US 5,700,962) also teaches away from the claimed invention via forming the neutron shielding material composition having a density of 2.5-2.8 g/cm³ containing density-increasing agents, such as metal powders (see, for example, abstract). *See In re Sebek*, 465 F.2d 904, 907 (CCPA 1972) ("Where, as here, the prior art disclosure suggests the outer limits of the range of suitable values..., the determination of optimum values outside that range may not be obvious."); *See also In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) ("A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.")

Kamoshida et al. (US 2003/0102445) teaches a neutron shielding material containing a hydrogenated bisphenol A type epoxy resin (see, for example, abstract). However, **Kamoshida et al.** fail to teach using other additional claimed materials, such as refractory material, boron compound, and density-increasing agents, in forming the neutron shielding material having the claimed density.

8. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hannah Pak whose telephone number is (571)270-5456. The examiner can normally be reached on Monday - alternating Fridays (7:30 am - 5 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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